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| 09/387,764 | 09/01/1999 | RAVI GANESAN | 33500-19D | 2988 |

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WASHINGTON, DC 200063404

EXAMINER

NGUYEN, NGA B

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| ART UNIT | PAPER NUMBER |
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3628

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/387,764

Applicant(s)
Ganesan et al.

Examiner
Nga B. Nguyen

Art Unit
3628



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 23, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Art Unit: 3628

DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on July 23, 2002, which paper has been placed of record in the file.
2. Claims 26-28 has been added. Claims 1-28 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Moreover, in the arguments, applicant stated that nowhere in Kitchen's teach an instruction to pay is transmitted by the user station to the biller station. Applicant argued far away the limitations in the claimed invention (claim 1), according to claim 1, an instruction to pay is transmitted by the user station to the central network station because the central network station receives the instruction to pay. "The transmitted information" that the biller received is unclear, it could be the relevant information. Examiner totally disagrees with applicant that Kitchen fails to disclose the determined amount of the available bill and the transmitted pay instruction are received by the central station in real time. See column 8, line 55-column 9, line 15, the user station transmits a payment instruction over the network to the central network station and the central network station perform an electronic fund transfer the appropriate amount to the biller account.

Art Unit: 3628

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-15, 26-28, "the transmitted information", the received information", "the determined amount", "the transmitted pay instruction", "the transmitted instruction to pay", "the relevant information"(claims 2), lack of antecedent basis;

Claims 16-25, "the received amount", "the received pay instruction" lacks of antecedent basis.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Art Unit: 3628

7. Claims 16-25, *insofar as they can be understood*, are rejected under 35 U.S.C. 102(e) as being anticipated by Kitchen et al, U.S. Patent No. 6,289,322.

Regarding to claim 16, Kitchen discloses an electronic bill payment system, comprising:
a database configured to store bill availability information identifying available bills of a plurality of different billers for a plurality of different users (column 6, lines 59-65);

a processor configured to receive a real time network communication of an amount of one of the available bills identified in the stored bill availability information for a first of a plurality of different users from a first of the plurality of different billers and a real time network communication of an instruction to pay the one available bill from the first user (column 6, lines 50-58 and column 8, lines 55-67); to generate a directive to pay the amount of the available bill based upon the received pay instruction, and to store the amount in the database in association with the bill availability information identifying the one available bill (column 8, line 63-column 9, line 29).

Regarding to claim 17, Kitchen discloses the processor is further configured to transmit the stored bill availability information identifying the one available bill for the first user, prior to receive the real time network communication of the amount and d of the instruction to pay (column 7, line 65-column 8, line 37).

Regarding to claim 18, Kitchen discloses the database is further configured to store the bill availability information so as to further identify those of the identified available bills which required information relevant to the amount of those bills; and the one available bill is one of

Art Unit: 3628

those of the plurality of available bills further identified as requiring relevant information (column 6, line 59-column 7, line 5).

Regarding to claim 19, Kitchen does not teach the database is further configured to stored a previously received amount of the available bill and the received amount of the one available bill (column 12, lines 65-column 13, line 5 and column 9, lines 15-20).

Claims 20-25 are written in computer software that parallel the limitations as found in claims 16-19 discussed above, therefore are rejected by the same rationale.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-15 and 26-28, ***insofar as they can be understood***, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen et al, U.S. Patent No. 6,289,322 in view of Official notice taken by Examiner.

Regarding to claims 1, 6, and 7, Kitchen discloses an electronic bill payment network, comprising:

a plurality of user network stations associated with a plurality of different users, a first of the plurality of user network stations being associated with a first of the plurality of different

Art Unit: 3628

users and operable to transmit, in real time, an instruction to pay the available bill (figure 1, items 120a-120d and column 8, lines 55-67) ;

a plurality of biller network stations associated with a plurality of different billers, a first of the plurality of biller network stations being associated with a first of the plurality of different billers and operable, in real time, to receive the transmitted information (figure 1, items 110a-110d and column 9, line 65-column 10, line 5); and

a central network station operable, in real time, to receive the determined amount of the available bill and the transmitted pay instruction, and to direct payment of the determined amount of the available bill based upon the transmitted instruction to pay that available bill (figure 1, item 140; column 6, lines 50-58 and column 8, lines 63-67).

Kitchen does not teach the user network station transmits information relevant to an amount of an available bill and the biller determines the amount of and available bill based on the relevant information such as product uses or meter reading. However, Kitchen does teach the user network station and the biller network station can communicate directly to transmit and receive the bill related information (column 9, line 65-column 10, line 5). Moreover, Official notice is taken that determining the amount of the available bill based on the relevant information transmitted from the user is well-known in the art. In most situations, the biller has the responsibility to determine the amount and due date for payment of a bill based on the user's usage information (The prior arts will be provided upon requested by Applicant). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made

Art Unit: 3628

to improve the method of Kitchen's by allowing the biller can determine the amount of the bill based on transmitted from the user for the purpose of allowing the user and the biller can communicate directly to exchange the bill related information.

Regarding to claim 2, Kitchen discloses the central network station is further operable to transmit bill availability information identifying at least two of the plurality of available bills for the first user; and the first user network station is further operable to receive the transmitted bill availability information, to select the available bill from the identified at least two available bills and to transmit a request for the available bill based upon the selection prior to transmitting the relevant information (column 7, lines 65-column 8, line 37).

Regarding to claim 3, Kitchen does not discloses the bill availability information identifies available bills without identifying an amount of each of the bills. Official notice is taken that it is obvious to modify the method of Kitchen in which the bill availability information does not contain an amount for the purpose of establishing the direct communication between the user and the biller to exchange the amount of the bill as discussed details in claim 1.

Regarding to claim 4, Kitchen further discloses a database configured to store the bill availability information so as to further identify those of the identified available bills which required information relevant to the amount of those identified available bills (column 6, line 59-column 7, line 5).

Regarding to claim 5, Kitchen further discloses the database is configured to store the determined amount (column 9, lines 15-20).

Art Unit: 3628

Regarding to claim 8, Kitchen further discloses the transmitted information is indicative of a disputed portion of a previously determined amount of the available bill (column 10, lines 32-42).

Regarding to claim 9, Kitchen discloses the first biller network station is further operable, in real time, to transmit the available bill including a previously determined amount, and the determined amount of the available bill represents an adjustment to the previously determined amount (column 10, lines 35-42).

Claims 10-15 are method claims that parallel the limitations as found in claims 1, 2, 4-7, 9 discussed above, therefore, are rejected by the same rationale.

Claims 26-28 are method claim that have similar limitations as found in claims 1, 2, 4, 5, as discussed above, therefore, are rejected by the same rationale.

Conclusion

10. Claims **1-28** are rejected.

11. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Kolling et al. (US 5,963,925) discloses an electronic statement presentment system replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery.

Art Unit: 3628

Heindel et al. (US 6,304,857) discloses an electronic billing system provides a set of tools for a biller to create and design a customized billing statement.

Neely (US 6,044,362) discloses a system for automated electronic invoicing and payment system for providing remote customer review of automated billing from an invoicer.

Ganesan et al. (US 6,334,116) discloses a method for centrally tracking transactions in an electronic billing system.

Dedrick (US 5,768,521) discloses general purpose metering mechanism for distribution of electronic information.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nga B. Nguyen, whose telephone number is (703)306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Souh, can be reached on (703)308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1113.

13. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks

c/o Technology Center 3600

Washington, D.C. 20231

or faxed to:

Art Unit: 3628

(703) 305-7687, (for formal communications intended for entry)

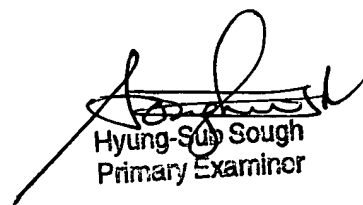
or:

(703) 308-3961 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen
October 18, 2002



Hyung-Sup Sough
Primary Examiner